

REMARKS

Applicant has reviewed and considered the Office Action mailed on August 25, 2003, and the references cited therewith.

The claims are not amended herein. Claims 23-42 are pending in this application.

§102 Rejection of the Claims

Claims 23-25, 32, 34-36 and 40-41 were rejected under 35 USC § 102(e) as being anticipated by Schultheiss (US 6,208,384). Applicant reserves the right to swear behind the reference at a later date. This rejection is respectfully traversed. Applicant respectfully submits that the Office Action did not make out a *prima facie* case of anticipation.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Claim 23 recites “at least one multimedia control device disposed within the housing to control only the multimedia device through the computer”. Schultheiss is lacking this element. The Office Action references key 62 as being such a control device. This assertion is respectfully traversed. “Middle keys 62 operate the infrared transmitter only...” Col. 5, line 49. Infrared signals are transmitted directly to the television at Col. 5, lines 37-39. Thus, key 62 does not control the multimedia device through the computer. Since an element is lacking in the reference, the rejection should be withdrawn.

Claim 23 also recites “wherein the at least one control device provides immediate accessibility to the multimedia device through the computer.” This element is also lacking. Key 62 was cited in the Office Action as providing this ability, however, as seen above, key 62 directly controls a television, not through the computer.

Claims 24, 25, 32 and 40 depend from claim 23 and are believed allowable for at least the same reasons.

Independent claim 34 and dependent claims 35-36 also contains at least one element not taught in Schultheiss. In particular, Schultheiss does not show "a control for controlling a function of the multimedia device such that actuation of the control causes the computer to control the function of the multimedia such that the function is immediately accessible via the pointing device". There is no control in Schultheiss that provides immediate accessibility to a function of the multimedia device **through the computer**. As previously indicated, key 62 communicates directly with the television, not through the computer.

Independent claim 42 also contains elements not taught in Schultheiss. Claim 42 recites "at least one multimedia control device disposed within the housing to control only the multimedia device through the computer". Schultheiss is lacking this element. The Office Action references key 62 as being such a control device. This assertion is respectfully traversed. "Middle keys 62 operate the infrared transmitter only..." Col. 5, line 49. Infrared signals are transmitted directly to the television at Col. 5, lines 37-39. Thus, key 62 does not control the multimedia device through the computer. Since an element is lacking in the reference, the rejection should be withdrawn.

Claim 42 also recites "wherein the at least one control device provides immediate accessibility to the multimedia device through the computer." This element is also lacking. Key 62 was cited in the Office Action as providing this ability, however, as seen above, key 62 directly controls a television, not through the computer.

§103 Rejection of the Claims

Claims 26, 33, 37 and 42 were rejected under 35 USC § 103(a) as being unpatentable over Schultheiss (US 6,208,384). This rejection is respectfully traversed. No additional art has been mentioned other than an apparent Official Notice taken with respect to a packetizing communication protocol. Such Official Notice is respectfully traversed. The Examiner is requested to provide a reference to support the assertion that "it would have been obvious to one having ordinary skill in the art at the time of the invention to allow signals from the computer cursor positioning device and the multimedia device control to include protocol information

including header, start transmission, text, end transmission information before the signals are transferred for appropriate transmission of the signals to the computer...” Absent a reference, it appears that the Examiner is using personal knowledge, so the Examiner is respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2). Even if such a reference or affidavit is provided, it would not provide the elements missing from the independent claims from which these depend, and which are already believed allowable. As such, claims 26, 37 and 42 are believed allowable.

Independent claim 33 also describes providing immediate accessibility to control the multimedia device through the computer via a multimedia device control on a mouse. The term “immediate accessibility” is used on page 9, lines 1-2 of the application: “Unlike software audio controls, the controls of the present invention are immediately accessible to the user.” Claim 33 recites “sending the multimedia device control signal from the computer to the multimedia device to provide immediate accessibility to control the multimedia device via the mouse.” This element is clearly lacking in Schultheiss, and the rejection should be withdrawn.

Claims 27-31, 38 and 39 were rejected under 35 USC § 103(a) as being unpatentable over Schultheiss (US 6,208,384) as applied to claims 23 and 34 above, and further in view of Schindler et al. (US 5,900,867). This rejection is respectfully traversed. Schindler et al. is cited for its use of a serial port. This teaching does not provide the elements of the independent claims from which these claims depend, and that are lacking in Schultheiss. Thus, since all the elements are not shown, taught or suggested by the combination of the references, the rejection should be withdrawn.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-373-6972) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-0439.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 25th day of November, 2003.

Candis B. Buending

Name

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